

REMARKS

Applicants request favorable reconsideration and withdrawal of the rejections set forth in the above-mentioned Office Action in view of the foregoing amendments and the following remarks.

Status of the Claims

Claims 1-21 remain pending, with Claims 1, 11, and 20 being independent claims. Claims 1, 11, and 20 have been amended. Support for the amendments can be found throughout the originally-filed disclosure, including, for example in Figures 1 and 2, as well as the corresponding description of these figures in the specification. Accordingly, Applicants submit that the amendments do not include new matter.

Substantive Rejections

Claims 1-5, 7, 10-16, 18, 20, and 21 are rejected under 35 U.S.C. § 103(a) over Chenevich et al. (U.S. Patent Publication No. 2002/0111886) in view of Berger et al. (U.S. Patent Publication No. 2002/0103752). Claims 6 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chenevich et al. in view of Berger et al. and Rose et al. (U.S. Patent No. 5,757,917). Claims 8 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chenevich et al. in view of Berger et al. and Williams et al. (U.S. Patent No. 5,815,657). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chenevich et al. in view of Campbell et al. (U.S. Patent Publication No. 2002/0023033).

Response to Rejections

In response, while not conceding the propriety of the rejections, independent Claims 1, 11, and 20 have been amended. Applicants submit that as amended, these claims are allowable for the following reasons.

Independent Claim 1 relates a method for identifying payment systems for facilitating the processing of payments by a supplier, comprising transmitting, querying, and returning steps. The transmitting step transmits payment criteria for purchase of a supplier's item by a customer from a customer computer to a supplier computer. The querying step queries a directory of payment systems in an attempt to locate one or more payment systems to process the transaction based at least in part upon the payment criteria. The returning step returns an identification of the one or more located payment systems, if any, to process the transaction, including information indicating whether the located payment systems match the payment criteria.

Claim 1 has been amended to recite a step of receiving with the supplier computer the payment criteria transmitted by the customer computer to the supplier computer. In addition, Claim 1 has been amended to recite that the querying step queries with the supplier computer a directory of payment systems in an attempt to locate one or more payment systems to process the transaction based at least in part upon the payment criteria.

In contrast, neither the Chenevich et al. publication nor the Berger et al. publication is understood to relate to a method in which a supplier computer receives customer payment criteria and queries a directory of payment systems, as recited by amended Claim 1. Rather, the Chenevich et al. publication is understood to use a

payment manager 20, separate from the supplier and the supplier's computer, to receive customer payment preferences and rules and to select a payment method based thereon, as discussed in paragraphs [0048] and [0051] - [0059]. Moreover, this citation is not understood to disclose how to translate the customer's preferences and payment rules into a specific payment method, such as the payment-systems-directory querying operation of amended Claim 1. The Berger et al. publication is understood to merely show a merchant computer 14 that receives data from the customer identifying the product or service to be purchased and customer credit card payment information, as discussed in paragraph [0006]. Thus, this citation is not understood to disclose the claimed transmission to or receipt by a supplier computer of payment criteria used by a querying operation to attempt to locate one or more payment systems based at least in part thereon.

More specifically, neither the Chenevich et al. publication nor the Berger et al. publication is understood to disclose or suggest:

- transmitting payment criteria for purchase of a supplier's item by a customer from a customer computer to a supplier computer, as recited by amended Claim 1;
- receiving with the supplier computer the payment criteria transmitted by the customer computer to the supplier computer, as recited by amended Claim 1;
- querying with the supplier computer a directory of payment systems in an attempt to locate one or more payment systems to process the transaction based at least in part upon the payment criteria, as recited by amended Claim 1; or
- a returning step of returning an identification of the one or more located payment systems, if any, to process the transaction, including information indicating whether the located payment systems match the payment criteria, as recited by amended Claim 1.

Rather, the Chenevich et al. publication is understood to disclose a payment manager 20, which is separate from the payor 4 or the payee 6 and their computers, that receives customer payment preferences and rules in its database 44, as discussed in paragraph [0048], and effects payment, as discussed in paragraphs [0042] and [0051] - [0059]. Such a system provides maximum flexibility in executing sales based on the preferences of both the customer and the seller, because the payment manager 20 has the ability to standardize and match payment methods across disparate payment vehicles, enabling execution of the preferred payment method selected by the buyer and the preferred payment method of the seller, even when these methods are completely different from each other, as discussed in paragraphs [0007] and [0008]. Since the payment manager 20 stores and uses the customer payment preferences and rules, rather than the supplier computer, Applicants do not understand this citation to disclose or suggest a step of receiving with the supplier computer the payment criteria transmitted by the customer computer to the supplier computer, as recited by amended Claim 1. Moreover, page 3 of the Office Action admits that this publication does not teach the transmission of the customer's payment criteria from the customer to the seller.

The Office Action does posit that the Chenevich et al. publication discloses the querying step recited in Claim 1. But amended Claim 1 recites that a) the querying operation is performed by the supplier computer, and b) a directory of payment systems is queried in an attempt to locate one or more payment systems to process the transaction based at least in part upon the received payment criteria. Applicants submit that the Chenevich et al. publication fails to disclose or suggest either feature a) or feature b) for the following reasons.

The Office Action states that the querying step is shown in paragraphs [0053] - [0055] and [0070] of the Chenevich et al. publication. However, as can be verified by reviewing those paragraphs, which are reproduced below, these portions of the Chenevich et al. publication appear to disclose merely that the payment selection system 32 of the payment manager 20 selects — in some unspecified way — a specific payment method using the stored payment rules preferred by the payor and payee. There does not appear to be any disclosure of how this selection of a specific payment method is performed based on the customer payment rules. Moreover, Applicants submit that there are many ways to select a payment method based on payment criteria, only one of which involves querying a payment-system directory in an attempt to locate one or more payment systems based at least in part upon the payment criteria, as recited by amended Claim 1. Accordingly, Applicants submit that the Chenevich et al. publication neither explicitly nor inherently discloses a payment selection operation using the payment-system-directory querying operation recited by amended Claim 1. In addition, paragraphs [0053] - [0055] and [0070] appear to disclose that selection and execution of the payment method is performed by the payment manager 20 rather than the supplier computer:

[0053] Advantageously, payment selection system 32 may select a payment method for payor 4 that is independent of a payment method selected for payee 6, in that the two payment methods may differ. As shown, payor 4 may have a plurality of available payment options, and payee 6 may have a plurality of available payment options, including options that differ from those available to payor 4. Using information from customer database 44 or from another source, payment selection system 32 may select a payment method for payor 4 such as by using business rules for payor 4. Independently, payment selection system 32 may select a payment method for payee 6, such as by using rules

for payee 6. In FIG. 2, this independent selection process is represented by two side-by-side sliding arrays of available payment methods that are aligned under a payment selection window according to payment rules. As a result, payment manager 20 is capable of standardizing and matching order information across all available payment methods or vehicles.

[0054] For example, for a particular transaction, payor 4 may put in place rules that require payment by credit card. For the same transaction, payee 6 may establish rules that require it to receive payment by wire transfer. Payment selection system 32 is capable of accommodating both payor 4 and payee 6 in such a situation. As a result, payment manager 20 is capable of serving payors and payees who do not agree on the particular payment method for a transaction. This ability allows payment manager 20 to serve customers without requiring prior negotiation between payor 4 and payee 6 regarding the payment terms of a transaction. In addition, payment may be accomplished more easily across borders, since payor 4 may pay in its local currency and payee 6 may be paid in its local currency, without having to negotiate such a payment plan with each other.

[0055] Payment rules may also be influenced by terms of contracts between payor 4 and payee 6. Payment selection system 32 may access information regarding contractual requirements between two parties and may select methods and timing of payments that meet the contractual terms.

[0070] Payees may also interact with payment manager 20 in a like manner. In particular, payees may establish rules for selecting preferred payment methods and for setting the timing of the payments. In particular, a payee can enroll with payment manager 20, although if the payee only needs to act as a payee, it could avoid presenting information regarding its ability to make payments. A payee may also choose to receive payments of a certain amount by a certain method, or may have multiple payments aggregated into a single payment.

Thus, the Chenevich et al. publication is understood to disclose the use of a separate payment manager 20 to store customer preferences and rules, and to select a

payment method using this stored data in some unspecified manner. Consequently, this publication is not understood to disclose or suggest the receiving step or the querying step, as recited by amended Claim 1.

Applicants also submit that the Berger et al. publication fails to cure the deficiencies in the Chenevich et al. publication. This publication is understood to merely show a method for enabling low-volume merchants to conduct e-commerce with established electronic payment vehicles, such as credit cards, without resorting to permanent payment processing accounts, and conventional methods using such permanent accounts, as discussed in paragraph [0001]. There does not appear to be any step of receiving payment criteria with the supplier computer, or querying a directory of payment systems with the supplier computer in an attempt to locate one or more payment systems based at least in part on the payment criteria to process the transaction, as also recited by amended Claim 1. The Office Action cites paragraph [0006] of this publication to show the claimed transmitting of customer payment criteria from a customer computer to a supplier computer. However, Applicants submit that this paragraph merely discloses a merchant computer 14 that receives data from the customer computer 12 identifying the product or service to be purchased and customer credit card payment information. Such specific credit card information, directing payment through one payment system (a specific credit card company) and not requiring a search in a payment-systems directory, is submitted to be completely different from the claimed payment criteria used by a querying operation to attempt to locate one or more payment systems based at least in part on the payment criteria:

[0006] FIG. 1b shows the real-time process flow of an online credit card purchase transaction using the

architecture shown in FIG. 1a. First, in step 40, the customer at his/her computer visits the merchant storefront web site, identifies the product or service of interest ("the commodity"), clicks on a "buy" (or equivalent) button, and enters customer identification information (e.g., name, shipping address) and credit card payment information. In step 42, the merchant storefront establishes a connection with the gateway entity, which retrieves the merchant identification data, such as the MID number, and transaction payment information. Next, in step 44, the gateway server establishes a connection with the credit card processing authority (e.g. FDMS) and uploads to it the MID number and transaction payment information (the credit card number and transaction amount). The financial processing authority then authorizes (or denies) the transaction with the card issuing bank in step 46, and notifies the gateway entity of the authorization/denial in step 48. It is then up to the gateway entity, in step 50, to notify the merchant and customer of the authorization so that the order can be fulfilled.

Since amended Claim 1 is understood to recite at least three features not disclosed or suggested by the Chenevich et al. and Berger et al. publications, Applicants submit that the Office has not yet satisfied its burden of proof to establish a prima facie case of obviousness against amended Claim 1. Therefore, Applicants respectfully request that the rejection of amended Claim 1 be withdrawn. And since amended Claim 20 recites similar receiving and querying steps, Applicants submit that the Office has not yet satisfied its burden of proof to establish a prima facie case of obviousness against amended Claim 20. Therefore, Applicants respectfully request that the rejection of amended Claim 20 be withdrawn. Further, since amended Claim 11 also recites a similar receiving step and also recites a querying step not understood to be disclosed or suggested by the Chenevich et al. and Berger et al. publications, Applicants submit that the Office has not yet satisfied its burden of proof to establish a prima facie case of

obviousness against amended Claim 11. Therefore, Applicants respectfully request that the rejection of amended Claim 11 be withdrawn.

The remaining claims in the present application are dependent claims that depend directly or indirectly from Claims 1, 11, or 20, and are allowable by virtue of their dependency and in their own right for further defining Applicants' invention. Favorable and independent consideration thereof is respectfully sought.

Provisional Rejection

Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-19 of copending Application No. 10/611,034.

In response, Applicants respectfully submit that the claims of Application No. 10/611,034 fail to recite, or otherwise suggest, a querying step to locate or attempt to locate one or more payment systems based at least in part on received payment criteria, as recited in Claims 1, 11, and 20. Since the Office Action fails to explain why it would have been obvious to one of ordinary skill to modify the claims of Application No. 10/611,034 to include this feature, the Office has not yet established that a prima facie case of obviousness-type double patenting could be made, should the copending application issue with its current claims. Therefore, Applicants respectfully request that the provisional rejection be withdrawn. Moreover, should the claims still be deemed obvious in view of the claims of Application No. 10/611,034, Applicants respectfully request that the provisional double-patenting rejection be held in abeyance until such time

that the claims of Application No. 10/611,034 or the present application are otherwise found allowable.

Conclusion

In view of the above amendments and remarks, the application is now in allowable form. Therefore, favorable reconsideration and early passage to issue of the present application is respectfully solicited.

Applicants' undersigned attorney may be reached in the Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to the below listed address.

Respectfully submitted,

/Gary M. Jacobs/

Attorney for Applicants
Registration No. 28,861

FITZPATRICK, CELLA, HARPER & SCINTO
1290 Avenue of the Americas
New York, NY 10104-3800
Facsimile: (212) 218-2200